

Application No.: 10/596,590
Filing Date: June 16, 2006

REMARKS

No claim has been amended. The attached 4th Declaration sets forth the data resulting from the experiments discussed with the Examiner. Applicant respectfully requests entry of the response and reconsideration of the present application in view of the remarks set forth below.

Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4, and 21-22 have been rejected under 35 U.S.C. § 103 as being unpatentable over Storow et al. (U.S. 3,069,375) in view of Swarup et al (U.S. 5,506,325). Applicant respectfully submits that rejected claims are allowable over the recited references as discussed below.

Claim 1 recites, among the other things, “a neutral silica sol...having a pH value of 5.0 to 7.8”. While Swarup et al is silent about the pH range, Storow’s disclosed pH range of 8 to 10. In rejecting the claim, the Examiner asserts that the instant claimed range of 5 to 7.8 and Storow’s disclosed range of 8 to 10 are so close to each other so that one skilled in the art would have expected them to have the same property. However, as indicated in a 4th Declaration attached hereto, newly submitted data along with the previously presented results in TABLE 2 of the specification and the data in the previously submitted declarations prove a criticality of the claimed range. Those data are consolidated in Table-2 of the 4th declaration. In particular, the samples indicate lower resistance to rain streaking and efflorescence resistance in Comparative Examples 1-4 (pH 8.0) and 1-6 (pH 4.5), while newly submitted Examples 1-10 to 1-12 and Example 1-13 to 1-15, whose pH value is 6.5 and 7.0 respectively, indicates excellent properties. These results along with the previously presented results from Example 1-1 to 1-7 whose pH is 7.6 and 7.8 prove a criticality of the claimed range. Moreover, as noted in the 4th Declaration paragraph 4, “the data from the newly submitted Example 1-8 to 1-9, along with Example 1-3, Examples 1-10 to 1-12, and Examples 1-13 to 1-15 show that different ratios of solid content within the claimed range all provide similar excellent results.” These unexpected results would effectively rebut any *prima facie* showing of obviousness, even if present. Consequently, no *prima facie* case of obviousness has been established with respect to Claim 1.

Application No.: 10/596,590
Filing Date: June 16, 2006

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from base Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

Claim Rejections – 35 U.S.C. § 103

Claim 2 has been rejected under 35 U.S.C. § 103 as being unpatentable over Storow et al in view of Swarup and further in view of Kano,

Claim 3 has been rejected under 35 U.S.C. § 103 as being unpatentable over Storow et al in view of Swarup and further in view of Kano and Gagliardi, and

Claims 1, and 21-22 have been rejected under 35 U.S.C. § 103 as being unpatentable over Storow et al in view of Inagaki.

Since the rejected claims depend from Claim 1 and the above cited references are silent about pH range of neutral silica sol, these are patentable with the same reason presented for Claim 1. Applicants respectfully request withdrawal of the rejection.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 4, 20-22, 25, and 26 have been rejected under 35 U.S.C. § 103 as being unpatentable over Weinberg et al in view of Swarup. Applicants respectfully submit that rejected claims are allowable over the recited references as discussed below.

Claim 1 recites, among the other things, “a neutral silica sol...having a pH value of 5.0 to 7.8” while Weinberg et al. recite “...a pH from about 7.0 to about 14.0...silica dispersion” While it is true that mere optimization range is not generally supportive of patentability, evidence indicating that the claimed ranges are critical can support patentability. See MPEP 2144.05(II). In the present case, the newly submitted data in the 4th declaration along with the previously presented results in TABLE 2 of the specification and the data in the previously submitted declarations prove a criticality of the claimed range. Those data are consolidated in Table-2 of the 4th declaration. The evidence show that a use of the neutral silica sol whose pH range is 5 to 7.8 remarkably improves resistance to rain streaking and efflorescence resistance, and the pH

Application No.: 10/596,590
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range is very critical for these properties. The data indicate that when the pH of 7.6 (Example 1-1 to 1-6, 1-8 and 1-9), 7.8 (Example 1-7), 6.5 (Examples 1-10 to 1-12), and 7.0 (Example 1-13 to 1-15), which is within recited range are applied to the materials, far superior results in the resistance to rain streaking and the efflorescence resistance were obtained, compared when the pH value is even slightly off, namely 4.5 (Comparative Example 1-6) and 8.0 (Comparative Example 1-4). These unexpected results rebut any prima facie case of obviousness based on the cited prior art. See MPEP 2144.05 (III) Applicant respectfully requests withdrawal of the rejection.

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from base Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.


Application No.: 10/596,590
Filing Date: June 16, 2006

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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